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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,410	03/16/2004	David L. Polston	P-109301.2(UTI)(CIP)	5095

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EXAMINER	
BRUNSMAN, DAVID M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,410	POLSTON, DAVID L.	
	Examiner	Art Unit	
	David M. Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,2,6,7 and 9-12* is/are rejected.

7)☒ Claim(s) *3-5 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20040614*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Reference B3 as illuminated by C1. Reference citation identifiers (e.g. B3 and C1) have been added the completed information disclosure statements, attached.

The instant claims are drawn to a method of preparing a composition for use as a road base wherein drilling waste is mixed with an aggregate material and combined with a binder to form road base. Reference B3 describes a report detailing the operations of an Osage Environmental waste treatment facility as of September 11, 1999. In this operation Drilling Waste (obtained from an oilfield – first site) is trucked to the facility and held on an impervious pad (third site), whereafter it is mixed with an aggregate (caliche and/or crushed brick) obtained from elsewhere (second site) about the facility. The treated waste is mixed with an asphaltic emulsion and cement as a binder to form the desired useful (structurally sound and environmentally safe) road base material. The report B3 details sampling and testing of the materials formed for leachate and suitability (e.g. material leaching large amounts of pollutants would be unsuitable for use as a road base). See also, reference C1. The report B3 constitutes convincing evidence that the process of the instant claims was known in public use starting no later that September 11, 1999. Applicant is invited to provide any further documentation detailing the process that has been performed at this site *along with clear explanation* of the manner in which that documentation supports or does not support a finding that the claimed invention was known and/or in use prior to the filing of the instant priority document.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference B3, as applied above, in view of Perry et al.

The difference between the reference and instant claim 2 is that the reference does not teach the specific equipment used to transport the aggregate and drilling waste prior to mixing or the mixed material. Perry et al teaches the use of screw augers to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste before the mixing step or mixed material in B3 by screw auger because Perry et al teaches screw augers are known to be effective to move bulk materials.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over B3, as applied above, in view of US Patent 6190106.

The difference between reference B3 and the instant claims is that the reference does not teach the specific equipment used to transport the waste and aggregate to the mixer. US 6190106 teaches the use of an excavator to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste to the mixer with an excavator because US 6190106 teaches excavators are known to be effective to move bulk materials.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman,* 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6, 9, 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6706108. Although the conflicting claims are not identical, they are not patentably distinct from each other because patented claims 1 and 2 teach every element of the instant claims: obtaining drilling waste (a species of oil and gas waste, see claim 2) from a first location, obtaining aggregate from second location, transporting both to a treatment site (third location) including a impervious layer for storing the materials and, mixing them together with a binder to form a road base material. The tests for leaching and suitability are implicitly disclosed by the recited intended use of the patent claims wherein the waste is to be stabilized and used as a road base. Testing to ensure that material has the properties required by the claim is implicit in the recitation of those properties.

Claims 2 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6706108, as set forth above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims do not set forth the specific equipment used to transport the aggregate and drilling waste prior to mixing or the mixed material. Perry et al teaches the use of screw augers to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste before the mixing step or mixed material in patented claims 1-2 by screw auger because Perry et al teaches screw augers are known to be effective to move bulk materials.

Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6706108 in view of US Patent 6190106.

The further difference between the patented claims and the instant claims is that the patented claims do not teach the specific equipment used to transport the waste and aggregate to the mixer. US 6190106 teaches the use of an excavator to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste to the mixer with an excavator because US 6190106 teaches excavators are known to be effective to move bulk materials.

Claims 1, 6, 9, 11 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/481671. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 3 of '671 teach every element of the instant claims: obtaining drilling waste (a species of oil and gas waste, see claim 3) from a first location, obtaining aggregate from second location, transporting both to a treatment site (third location) including a impervious layer for storing the materials and, mixing them together with a binder to form a road base material. The tests for leaching and suitability are implicitly disclosed by the recited intended use of the patent claims wherein the waste is to be stabilized and used as a road base. Testing to ensure that material has the properties required by the claim is implicit in the recitation of those properties. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 2 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of 10/481671, as set forth above. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the claims of '671 do not set forth the specific equipment used to transport the aggregate and drilling waste prior to mixing or the mixed material. Perry et al teaches the use of screw augers to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste before the mixing step or mixed material in claims 1-2 of '671 by screw auger because Perry et al teaches screw augers are known to be effective to move bulk materials. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of 10/481671 in view of US Patent 6190106.

The further difference between the claims of '671 and the instant claims is that the '671 claims do not teach the specific equipment used to transport the waste and aggregate to the mixer. US 6190106 teaches the use of an excavator to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste to the mixer with an excavator because US 6190106 teaches excavators are known to be effective to move bulk materials. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 6, 9, 11 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of copending Application No. 10/736337. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 3 of '337 teach every element of the instant claims: obtaining drilling waste (a species of oil and gas waste, see claim 3) from a first location, obtaining aggregate from second location, transporting both to a treatment site (third location) including a impervious layer for storing the materials and,

mixing them together with a binder to form a road base material. The tests for leaching and suitability are implicitly disclosed by the recited intended use of the patent claims wherein the waste is to be stabilized and used as a road base. Testing to ensure that material has the properties required by the claim is implicit in the recitation of those properties. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 2 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of 10/736337, as set forth above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '337 do not set forth the specific equipment used to transport the aggregate and drilling waste prior to mixing or the mixed material. Perry et al teaches the use of screw augers to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste before the mixing step or mixed material in claims 1-2 of '337 by screw auger because Perry et al teaches screw augers are known to be effective to move bulk materials. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of 10/736337 in view of US Patent 6190106.

The further difference between the claims of '337 and the instant claims is that the '337 claims do not teach the specific equipment used to transport the waste and aggregate to the mixer. US 6190106 teaches the use of an excavator to transport bulk materials. It would have been obvious to one of ordinary skill in the art to transport the aggregate and drilling waste to the mixer with an excavator because US 6190106 teaches excavators are

known to be effective to move bulk materials. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 3-5 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The published prior art of record fails to teach or suggest a method of forming a road base from a mixture of drilling waste aggregate and binder wherein the aggregate and drilling waste are passed through a screen or passed through a separator place above the mixer of the mixing step. The prior art as a whole teaches away from any kind of preliminary treatment of the waste materials before stabilization.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

OMB